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Docket No.: 600.1290
Date: December 1, 2008

In re application of: **KAISER et al.**
Serial No.: 10/730,471
Filed: December 8, 2003
For: **METHOD AND SYSTEM FOR DIGITAL IMAGING OF PRINTING FORMS**

Sir:

Transmitted herewith is an **Appeal Brief including Appendices A, B & C (13 pgs)** in the above-identified application.

- ☒ Also transmitted herewith are:
- ☐ Petition for extension under 37 C.F.R. §1.136
 - ☒ Return Receipt Postcard
 - ☐ Other:
- ☒ Check(s) in the amount of **\$540.00** is/are attached to cover:
- ☐ Filing fee for additional claims under 37 C.F.R. §1.16
 - ☐ Petition fee for extension under 37 C.F.R. §1.136
 - ☒ Other: **Fee for Filing a Brief in Support of an Appeal under 37 C.F.R. §41.20(b)(2)**
- ☒ The Assistant Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-0552.
- ☒ Any filing fee under 37 C.F.R. §1.16 for the presentation of additional claims which are not paid by check submitted herewith.
 - ☒ Any patent application processing fees under 37 C.F.R. §1.17.
 - ☒ Any petition fees for extension under 37 C.F.R. §1.136 which are not paid by check submitted herewith, and it is hereby requested that this be a petition for an automatic extension of time under 37 CFR §1.136.


William C. Gehris, Reg. No. 38,156

DAVIDSON, DAVIDSON & KAPPEL, LLC
485 Seventh Avenue, 14th Floor
New York, New York 10018
Tel: (212) 736-1940
Fax: (212) 736-2427

I hereby certify that the documents referred to as attached therein and/or fee are being deposited with the United States Postal Service as "first class mail" with sufficient postage in an envelope addressed to "Mail Stop: APPEAL BRIEF- PATENTS Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on December 1, 2008.

DAVIDSON, DAVIDSON & KAPPEL, LLC

BY: 
Clint R. Mehall

Application No.: 10/730,471
Appeal Brief



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Re: Application of: **KAISER et al.**, Art Unit: 2854
Serial No.: 10/730,471 Confirmation No.: 2875
Filed: December 8, 2003 Atty. Docket: 600.1290
Examiner: Joshua D. Zimmerman Customer No.: 23280
For: **METHOD AND SYSTEM FOR DIGITAL IMAGING OF
PRINTING FORMS**

Mail Stop: APPEAL BRIEF – PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

December 1, 2008

APPELLANTS' BRIEF UNDER 37 C.F.R. § 41.37

Sir:

Appellants submit this brief for the consideration of the Board of Patent Appeals and Interferences (the "Board") in support of their appeal of the Final Rejection dated June 25, 2008 in this application. A check in the amount of \$540.00 for filing an appeal brief is paid concurrently herewith. If any additional fees are deemed to be due at this time, the Assistant Commissioner is authorized to charge payment of the same to Deposit Account No. 50-0552.

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I. REAL PARTY IN INTEREST

The real party in interest is Heidelberger Druckmaschinen AG, a corporation having a place of business in Heidelberg, Germany, and the assignee of the entire right, title and interest in the above-identified patent application. The invention was assigned to Heidelberger Druckmaschinen AG by an assignment originating from inventors Michael Kaiser and Ludo Kerz. The most recent assignment was recorded on December 8, 2003 at reel 015533, frame 0344.

II. RELATED APPEALS AND INTERFERENCES

Appellants, their legal representatives, and assignee are not aware of any appeal, interference or judicial proceeding that directly affects, will be directly affected by, or will have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1 to 10 are pending. Claims 1 to 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of Robotham et al. (U.S. 2002/0015042).

The rejection to claims 1 to 10 thus is appealed. A copy of appealed claims 1 to 10 is attached hereto as Appendix A.

IV. STATUS OF AMENDMENTS AFTER FINAL

No amendments to the claims were filed after the final rejection. A Notice of Appeal was filed on September 25, 2008 and received by the U.S.P.T.O. on September 29, 2008.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 recites a method for digital imaging of a printing form through application of energy (e.g., Fig. 6; e.g., specification at page 12, lines 5 to 25, paragraph [0040]), the printing form (e.g., 10 in Fig. 4; e.g., specification at page 10, line 3, paragraph [0033]) having a burn-off area (e.g., 66 in Fig. 4; e.g., specification at page 10, lines 13 to 14, paragraph [0034]) detachably fixed by supporting points (e.g., 68 in Fig. 4; e.g., specification at page 10, lines 18 to 19, paragraph [0035]) in the burn-off area, the supporting points being left in place on

the printing form through non-imaging of image spots (e.g., specification at page 9, lines 25 to 28, paragraph [0032]), the method comprising the steps of:

leaving in place at least one of the supporting points in at least one reference point if a number of image spots to be imaged in a surrounding area of the reference point exceeds a limit value and a boundary area in the surrounding area around the reference point contains only image spots to be imaged (e.g., Fig. 2; e.g., specification at page 8, line 19 to page 9, line 18, paragraphs [0029] to [0031]; e.g. specification at); and

detaching burn-off from the burn-off area from the printing form in a cleaning step (e.g. specification at page 9, line 29, paragraph [0032]).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 to 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of Robotham et al. (U.S. 2002/0015042).

V. ARGUMENTS

A. Rejection under 35 U.S.C. §103(a)

1. Claims 1 to 10

Claims 1 to 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of Robotham et al.

Robotham et al. relates to the display of visual content on a client device using rasterized representations of visual content. The visual content is rendered on a server system, transformed into bitmaps compatible with the display attributes of a client device, and transmitted for display on the client device. Some of the types of content displayed on the client device are web pages, email, electronic documents, database queries and drawings. (See paragraph [0014]).

Claim 1 recites “[a] method for digital imaging of a printing form through application of energy, the printing form having a burn-off area detachably fixed by supporting points in the burn-off area, the supporting points being left in place on the printing form through non-imaging of image spots, the method comprising the steps of:

leaving in place at least one of the supporting points in at least one reference point if a number of image spots to be imaged in a surrounding area of the reference point exceeds a limit value and a boundary area in the surrounding area around the reference point contains only image spots to be imaged; and

detaching burn-off from the burn-off area from the printing form in a cleaning step.”

It is respectfully submitted that neither AAPA nor Robotham et al. discloses “leaving in place at least one of the supporting points in at least one reference point if a number of image spots to be imaged in a surrounding area of the reference point exceeds a limit value and a boundary area in the surrounding area around the reference point contains only image spots to be imaged” as recited in claim 1. AAPA discloses that supporting points were simply set at uniform intervals and does not in any way disclose taking into account image spots of “a surrounding area of at least one reference point” or “a limit value,” as recited in claim 1. (See present specification, paragraph [0008]). Robotham et al., at paragraph [0186], discloses that bitmap representations of images may be compressed on a server before they are transmitted to a client. It is respectfully submitted that Robotham et al. in no way cures the deficiency of the AAPA, because image compression, which as stated at Page 6, Item 5 of the Office Action “is used to reduce the amount of data associated with a bitmap representation,” in no way relates to the “supporting points” of claim 1, which are physical pieces of a printing form, or taking into account “image spots to be imaged in a surrounding area,” as recited in claim 1.

Furthermore, it is respectfully submitted that contrary to the Examiner’s assertion at Page 6, Item 5 of the Office Action, there is no indication in AAPA or Robotham et al. that the loss-less image compression technique discussed in Robotham et al. inherently cures the deficiencies of AAPA with respect the “leaving” step of claim 1. The Examiner admits that AAPA only discloses leaving in place at least one of the supporting points and not “leaving in place at least one of the supporting points in at least one reference point if a number of image spots to be imaged in a surrounding area of the reference point exceeds a limit value and a boundary area in the surrounding area around the reference point contains only image spots to be imaged” as required by claim 1. It is respectfully submitted that because the Examiner relies on the loss-less image compression technique of Robotham et al. as inherently disclosing the “leaving” step of claim 1, but does even attempt to provide any support for this assertion, the Examiner has failed to establish that the loss-less image compression technique of Robotham et al. inherently

discloses the “leaving step” of claim 1. (See MPEP 2112: “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ”). Thus, it is respectfully submitted that the Examiner fails to establish a prima facie case of obviousness with respect to claim 1.

Furthermore, it is respectfully submitted that one of skill in the art would not have modified AAPA in light of Robotham et al. to meet the limitations of claim 1. AAPA involves the creation of supporting points by leaving an un-imaged dot in the burn-off area of a printing form, by modifying the image data to replace individual set bits (on bits, “1”) with un-set bits (off bits, “0”). (See present specification, paragraphs [0006], [0008]). Robotham et al. involves optionally compressing the visual content on a server before the visual content is sent from the server to the client to help reduce the amount of data transmitted. (See Robotham et al., paragraphs [0082], [0186]). Image compression is “used to reduce the amount of data associated with a bitmap representation” and thus decreases the total number of bits associated with the visual content. (Office Action, Page 6, Item 5). Because AAPA teaches leaving the total amount of bits unchanged and Robotham et al. teaches reducing the total number of bits, the references themselves teach away from their combination. Thus, combining AAPA and Robotham et al., it is respectfully submitted, is improper and claim 1 is not unpatentable in view of AAPA and Robotham et al. (MPEP 2145).

It is also respectfully submitted that the Examiner’s statement that Robotham et al. discloses “essentially what applicants are doing” demonstrates that the Examiner is impermissibly attempting to distill the invention of claim 1 down to a gist of the invention and that the Examiner is failing to consider the language of claim 1 as a whole. (MPEP 2141.02). It is respectfully submitted that the Examiner ignores the fact that claim 1 involves a “method for digital imaging of a printing form” that includes leaving in place physical pieces of a printing form, and solely focuses on differences between actions taken upon bits. (MPEP 2141.02: “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed

invention as a whole would have been obvious.”) This is another reason why claim 1 is not unpatentable in view of AAPA and Robotham et al.

Withdrawal of the rejection under 35 U.S.C. §103(a) of claim 1, and claims 2 to 10 depending therefrom, is respectfully requested.

2. Claim 3 Argued Separately

It is respectfully submitted that neither AAPA nor Robotham et al. discloses “[t]he method as recited in claim 1 further comprising a calibration step prior to the leaving in place step wherein a geometric shape and extent of the surrounding area and/or the limit value and/or the geometric shape and extent of the boundary area and/or the distance from a first reference point to a second reference point of the at least one reference point is determined” as recited in claim 3 and it would not have been obvious to one of skill in the art to have combined the references to meet this limitation. It is respectfully submitted that Robotham et al. does not explicitly or inherently disclose the additional limitations of claim 3 and the Examiner fails to in any way indicate how or where Robotham et al. discloses these limitations. (See MPEP 2112: “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill”).

3. Claim 5 Argued Separately

It is respectfully submitted that neither AAPA nor Robotham et al. discloses “[t]he method as recited in claim 1 wherein the distance from a first reference point to a second reference point of the at least one reference point matches an extent of the boundary area” as recited in claim 5 and it would not have been obvious to one of skill in the art to have combined the references to meet this limitation. It is respectfully submitted that Robotham et al. does not explicitly or inherently disclose the additional limitations of claim 5 and the Examiner fails to in any way indicate how or where Robotham et al. discloses these limitations. (See MPEP 2112: “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so

recognized by persons of ordinary skill”).

CONCLUSION

It is respectfully submitted that the application is in condition for allowance. Favorable consideration of this appeal brief is respectfully requested.

Respectfully submitted,

DAVIDSON, DAVIDSON & KAPPEL, LLC

By: _____



William C. Gehris
(Reg. No. 38,156)

DAVIDSON, DAVIDSON & KAPPEL, LLC
485 Seventh Avenue, 14th Floor
New York, NY 10018
Tel: (212) 736-1940
Fax: (212) 736-2427

APPENDIX A

CLAIMS 1 to 10 of
U.S. APPLICATION NO. 10/730,471

Claim 1 (previously presented): A method for digital imaging of a printing form through application of energy, the printing form having a burn-off area detachably fixed by supporting points in the burn-off area, the supporting points being left in place on the printing form through non-imaging of image spots, the method comprising the steps of:

leaving in place at least one of the supporting points in at least one reference point if a number of image spots to be imaged in a surrounding area of the reference point exceeds a limit value and a boundary area in the surrounding area around the reference point contains only image spots to be imaged; and

detaching burn-off from the burn-off area from the printing form in a cleaning step.

Claim 2 (original): The method as recited in claim 1 wherein the number of image spots to be imaged in a surrounding area of a reference point is determined in an analysis of the image data represented in digital form as a bit field.

Claim 3 (original): The method as recited in claim 1 further comprising a calibration step prior to the leaving in place step wherein a geometric shape and extent of the surrounding area and/or the limit value and/or the geometric shape and extent of the boundary area and/or the distance from a first reference point to a second reference point of the at least one reference point is determined.

Claim 4 (original): The method as recited in claim 1 wherein the at least one reference point includes a plurality of reference points distributed in a uniform grid over a printing area of the printing form.

Claim 5 (original): The method as recited in claim 1 wherein the distance from a first reference point to a second reference point of the at least one reference point matches an extent of the boundary area.

Claim 6 (original): A system for digital imaging of printing forms in a method as recited in claim 1, the system comprising:

an energy source,

a cleaning unit,

a control unit, and

an image processing unit with a computing unit,

wherein in the computing unit of the image processing unit a program is executable, the program having at least one executable step determining whether the limit value has been exceeded at a number of positions in a bit field representing the image data in digital form, the positions corresponding to the reference points.

Claim 7 (original): The system as recited in claim 6 wherein the image processing unit includes a raster image processor and a data buffer for the image data represented in digital form as a bit field.

Claim 8 (original): The system as recited in claim 6 wherein the program has at least one executable step for modifying the bit field in at least one area at the positions at which the limit value is exceeded.

Claim 9 (original): A printing unit comprising a system for imaging as recited in claim 6.

Claim 10 (original): A printing press comprising a printing unit as recited in claim 9.

APPENDIX B

Evidence Appendix under 37 C.F.R. §41.37 (c) (ix):

No evidence pursuant to 37 C.F.R. §§1.130, 1.131 or 1.132 and relied upon in the appeal has been submitted by appellants or entered by the examiner.

APPENDIX C

Related proceedings appendix under 37 C.F.R. §41.37 (c) (x):

As stated in “2. RELATED APPEALS AND INTERFERENCES” of this appeal brief, appellants, their legal representatives, and assignee are not aware of any appeal or interference that directly affects, will be directly affected by, or will have a bearing on the Board’s decision in this appeal.